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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,194	01/04/2005	Michael Adrianus Henricus Van Der Aa	NL 020611	2564

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BRIARCLIFF MANOR, NY 10510

EXAMINER

KLIMOWICZ, WILLIAM JOSEPH

ART UNIT

PAPER NUMBER

2627

DATE MAILED: 11/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/520,194

**Applicant(s)**

VAN DER AA ET AL.

**Examiner**

William J. Klimowicz

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,11 and 12 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Status***

Claims 3 and 4 have been cancelled.

Claims 1, 2, and 5-12 are currently pending.

### ***Claim Rejections - 35 USC § 112***

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 12, the phrase “wherein the disc has the dimensions of a coin” is vague and ambiguous. More concretely, it is unclear as to what “coin” is being referenced? An American half-dollar, a roman coin, a British coin? It is noted that the British 50p (Fifty Pence) coin is even non-circular.

Thus, the metes and bounds of claim 12 are unascertainable.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Butz (GB 2 037 475 A).

As per claim 1, Butz (GB 2 037 475 A) discloses a disc (Figure 2) comprising a protective plate (1) and a substrate layer (e.g., 2) having a support plate (bottom portion of (2) and/or (10)) and a registration layer (information recording area of disc (9)) connected to the support plate (bottom portion of (2) and/or (10)), said protective plate (1) being located at the side of the registration layer remote from the support plate (bottom portion of (2) and/or (10)), and said protective plate (1) being detachably fastened to the substrate layer (bottom portion of (2) and/or (10)), wherein the protective plate (1) is magnetically fastened to the substrate layer (bottom portion of (2) and/or (10)) - via magnets (25).

As per claim 2 characterized in that the support plate (bottom portion of (2) and/or (10)) has the shape of a disc and is provided with at least one raised edge ((e.g., vertical extending portions of (2) and/or (10)) extending upwards from a circumferential edge, by means of which the protective plate (1) can be detachably fastened.

As per claim 5, characterized in that the substrate layer (2) is insertable (i.e., *capable* of being inserted) into a protective element which comprises at least the protective plate (1) - (e.g., is adapted to be inserted into any protective element).

As per claim 6, characterized in that at least an outer circumferential edge of the substrate layer (2) or of the protective plate (1) is provided with a groove - see Figure 3, the interface between (1) and (2).

As per claim 7, characterized in that the registration layer (recording layer) is provided with a covering layer (e.g., 11) at a side facing away from the support plate (bottom portion of (2) and/or (10)).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Butz (GB 2 037 475 A).

See the description of Butz (GB 2 037 475 A), *supra*.

With regard to claim 11, although Butz (GB 2 037 475 A) discloses using a magnetic recording disc, Official notice is taken that optical recording discs (e.g., magneto-optical disc containing magnetic recording surfaces, DVD's CD-ROM's, etc.) are notoriously old and well known and ubiquitous in the art; such Officially noticed fact being capable of instant and unquestionable demonstration as being well-known.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the disk cartridge pack of Butz (GB 2 037 475 A) as utilizing a conventional optical disc.

The rationale is as follows: one of ordinary skill in the art would have been motivated to have provided the disk cartridge pack of Butz (GB 2 037 475 A) as utilizing a conventional

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optical disc in order to provide the same beneficial effects espoused by Butz (GB 2 037 475 A) to an optical recording disc that is protected from the environment.

### ***Response to Arguments***

Applicant's arguments filed October 11, 2006 have been fully considered but they are not persuasive.

The Applicant contends that "Butz does not show or suggest a disc that is provided with a protective layer that is magnetically fastened to a substrate layer." See page 6 of Applicant's response filed October 11, 2006.

The Examiner respectfully disagrees based on the scope of the claims currently rejected. More concretely, as set forth, *supra*, Butz (GB 2 037 475 A) discloses a disc (Figure 2) comprising a protective plate (1) and a substrate layer (e.g., 2) having a support plate (bottom portion of (2) and/or (10)). The protective plate (1) is detachably fastened to the substrate layer (bottom portion of (2) and/or (10)), wherein the protective plate (1) is magnetically fastened to the substrate layer (bottom portion of (2) and/or (10)) - via magnets (25).

Certainly, if the protective layer wasn't magnetically fastened to a substrate layer, the bottom (2) would fall out from the container top (1). Moreover, as set forth on page 2, lines 86-91, "[t]o keep the removable bottom cover 2 latched to the top cover, the removable bottom cover is provided with magnets 25 that are attracted to an annular armature plate 26 secured to the underside of the disk hub 12." [Such disk hub 12, being interconnected to the top cover].

Pertaining to the claims rejected under 35 U.S.C. § 102 as being anticipated by the disclosure of Butz (GB 2 037 475 A) the following should be noted. Anticipation is established

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only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); *cert. dismissed*, 468 U.S. 1228 (1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 72.1 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

The Examiner, as clearly articulated in the rejection, *supra*, has set forth a one-to-one correspondence with each and every element of the *claimed* invention. More concretely, as recited MPEP§2106:

Office personnel are to give claims their ***broadest reasonable interpretation*** in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). ***Limitations appearing in the specification but not recited in the claim are not read into the claim.*** *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. . . . The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. . . . An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”). [Emphasis in bold italics added].

Moreover, one must also bear in mind that limitations contained within Applicant’s arguments cannot be read into the claims for the purpose of avoiding prior art. *In re Sporck*, 386 F.2d 924, 155 USPQ 687 (CCPA 1968).

As set forth in the MPEP§ 706, “the standard to be applied in all cases is the “preponderance of the evidence” test. In other words, an examiner should reject a claim if, in

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view of the prior art and evidence of record, it is more likely than not that the claim is unpatentable.” Clearly, the Examiner has established that one of ordinary skill in the art would *reasonably* construe the one-to-one correspondence with each and every element of the *claimed* invention, in the manner set forth in the rejection, *supra*, by at least the *preponderance* of the evidence. The Applicant’s arguments have fallen well short of rebutting the Examiner’s *prima facie* case of anticipation.

### ***Allowable Subject Matter***

Claims 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



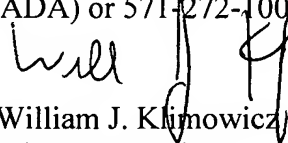
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (571) 272-7577. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
William J. Klimowicz  
Primary Examiner  
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WJK